



05-01-06

IPW

Please type a plus sign (+) inside this box →

[+]

PTO/SB/21 (05-03)

Approved for use through 04/30/2003. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM

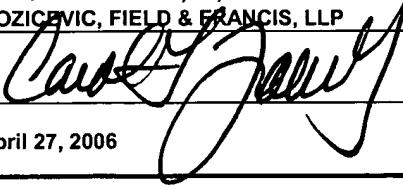
(to be used for all correspondence after initial filing)

		Application Number	10/656,803
		Filing Date	September 4, 2003
		First Named Inventor	GREENE, WARNER C.
		Group Art Unit	1648
		Examiner Name	Boesen, Agnieszka
Total Number of Pages in This Submission	4	Attorney Docket Number	UCAL-283

ENCLOSURES (check all that apply)

<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Assignment Papers (for an Application)	<input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment / Reply	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input checked="" type="checkbox"/> Response to Restriction Requirement
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	<input type="checkbox"/> Postcard
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Certified Copy of Priority Documents	<input type="checkbox"/> CD, Number of CD(s)	
<input type="checkbox"/> Response to Missing Parts/ Incomplete Application		
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Signing Attorney/Agent (Reg. No.)	CAROL L. FRANCIS, 36,513 BOZIC-PVIC, FIELD & FRANCIS, LLP
Signature	
Date	April 27, 2006

EXPRESS MAIL LABEL NO. EV 687 637 293 US

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



Atty Dkt. No.: UCAL-283
USSN: 10/656,803

Express Mail No. EV 687 637 293 US

RESPONSE TO RESTRICTION REQUIREMENT Address to: Mail Stop Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Docket No.	UCAL-283
	Application No.	10/656,803
	Confirmation No.	7086
	Filing Date	September 4, 2003
	Examiner	Boesen, Agnieszka
	Group Art Unit	1648

Sir:

This communication is submitted in response to the Restriction Requirement dated March 30, 2006. The Examiner therein required election of one of the following groups of claims:

- I. Claims 1-15, drawn to a method for detecting fusion of an enveloped retrovirus to a target cell, the method comprising contacting a target cell with an enveloped retroviral virion containing a chimeric viral protein comprising a reporter polypeptide;
- II. Claim 16-19, drawn to a method for identifying an agent that modulates fusion of HIV virion to a target cell, the method comprising contacting a target cell with a candidate agent and with an HIV virion containing a chimeric viral protein;
- III. Claim 20-22, drawn to a method for identifying a viral envelope protein that facilitates viral fusion to a target cell, the method comprising contacting a target cell with a pseudotyped HIV virion;
- IV. Claim 23, drawn to a method for identifying a viral envelope protein, wherein the method further comprises contacting the target cell with a candidate agent that facilitates viral fusion to a target cell;
- V. Claim 24 and 25, drawn to an isolated chimeric viral protein;
- VI. Claim 29, drawn to an isolated enveloped virion;
- VII. Claim 26, 27 and 28, drawn to an isolated polynucleotide sequence; and
- VIII. Claim 30 and 31, drawn to a kit for detecting fusion of an enveloped virion to a target cell.

Applicants hereby elect to prosecute the claims of Group I, claims 1-15 with traverse.

As stated in the MPEP §803, if search and examination of an entire application can be made without serious burden, the examiner must examine) the entire application on the merits, even though the entire application includes claims to independent or distinct inventions. MPEP §803 also states that

a serious burden on the examiner may be *prima facie* shown by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02.

In the present application, the method claims of Groups I-IV can readily be examined together with an undue burden. All of these claims in Groups I-IV requires use of a retroviral virion having a chimeric viral protein, which has a reporter polypeptide operably joined to a viral accessory protein. An exemplary chimeric viral protein is the BlaM-VpR fusion protein. A search to identify relevant art to the claims of Group I with respect to the use of a chimeric viral protein as recited in the claims would also identify art relevant to the claims of Groups II - IV.

Likewise, a search to identify art for a chimeric viral protein of Group V would also identify art relevant to an isolated enveloped virion having a chimeric viral protein of Group VI. Furthermore, the kit claims of Group VIII should be examined with Groups containing claims directed to the compositions present in the kits (e.g., the chimeric viral protein claims and the claims directed to a polynucleotide encoding the chimeric viral protein).

In the instant case, the Office asserts that

the methods of Groups I, II, II [sic] and IV have different methods steps and use different reagents. A search for a method of identifying a viral envelope protein that facilitates viral fusion to a target cell of Group III is not co-extensive with a search for a method further comprising contacting the target cell with a candidate agent that facilitates viral fusion to a target cell of Group IV.

Office Action page 4.

The Office goes on to state that because the claims do not overlap in scope, that restriction is proper.

Applicants respectfully submit that the above basis for the restriction requirement is improper. Simply because claims are not of the same scope is not an appropriate basis for requiring restriction of the claims. Further, although the Office states that searches for Groups I, II, III, IV, and V would not be co-extensive, all of these Groups are assigned to the same class and subclass -- class 435, subclass 5.

Accordingly, the Applicants traverse the restriction requirement, and request its withdrawal.

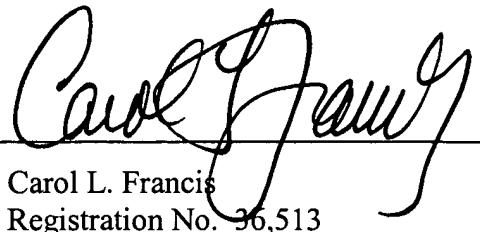
The Applicants expressly reserve the right under 35 USC §121 to file a divisional application directed to the non-elected subject matter or any subject matter disclosed in this application during the pendency of this application.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-0815, order number UCAL-283.

Respectfully submitted,
BOZICEVIC, FIELD & FRANCIS LLP

Date: April 27, 2006

By:



Carol L. Francis
Registration No. 36,513

BOZICEVIC, FIELD & FRANCIS LLP
1900 University Avenue, Suite 200
East Palo Alto, California 94303
Telephone: (650) 327-3400
Facsimile: (650) 327-3231